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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/902,048

Filing Date: July 10, 2001

Appellant(s): VATTER, MICHAEL LEE

JUL 02 2007

GROUP 1600

Juliet A. Jones
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 2, 2007 appealing from the Office action
mailed December 23, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US Patent 5,654,362 Schulz Jr. et al. August 5, 1997

US Patent 6,071,503 Drechsler et al. June 6, 2003

US Patent 5,534,265 Fowler et al. July 9, 1996

(9) Grounds of Rejection

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz Jr. et al. (US 5,654,362) in view of Drechsler et al. (US 6,071,503) and in further view of applicants' admission and Fowler et al. (US 5,534,265).

Schulz Jr. et al. teach the silicone elastomer powders herein employed¹. The elastomer powders are made by cross-linking silicone-containing precursors (see col. 2, lines 1-59). The silicone oils include polymethylsiloxane, also known as dimethicone (see col. 4, lines 28-45). Common ingredients to be used with the elastomers of Schulz include propylene glycol (see col. 5, lines 1-5). Glycol functional siloxane fluids are taught as useful with the elastomeric compositions, (see col. 4, lines 45-55). Schulz Jr. et al. teach that the compositions are useful for

various personal and facial cleansers and that they function as color cosmetic removers (see col. 7, lines 41-60). Additionally, Schulz Jr. et al. teach that the compositions are useful as delivery systems for oil and water-soluble substances such as vitamins. Table I includes an emollient (see col. 6, lines 44-67). Further, Schulz Jr. et al. teach composition comprising the elastomers as powder (see column 2, lines 11-21, examples III, col. 7, lines 34-60 and claim 12). The elastomer as cosmetic ingredient provides a variety of benefit to cosmetic composition. See, particularly, cols 7-8.

Schulz Jr. et al. do not teach expressly method of makeup removal that specifically includes transfer resistant makeup as well as composition that include a substrate as a tissue.

However, Drechsler et al. teach transfer resistant cosmetic compositions. The compositions of Drechsler contain a silicone gum or resin base (see the examples 1 and 2, col. 15, line 20 through col. 16, line 30). Drechsler et al. teach that the compositions may be removed by applying petrolatum or a dimethicone-based cosmetic remover to the skin or lips and rubbing the area gently with a tissue (see col. 15, lines 15-18).

It would have been *prima facie* obvious to one of ordinary skill in the art, at the time the claimed invention was made to incorporate the silicone elastomer disclosed by Schulz into a petrolatum or dimethicone-based cosmetic remover in order to benefit from the removal of transfer resistant makeup as taught by Drechsler. As to the particular amounts the elastomer herein or the viscosity herein claimed, note the optimization of a result effective parameter, e.g., the optimal amounts of a cosmetic ingredient or the viscosity of a cosmetic composition, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

¹ The specification discloses that the silicone elastomer powders disclosed by Schulz Jr. et al. are useful in the

Further, the employments of old and well-known cosmetic ingredients, such as propylene glycol, polypropylene glycol, or dimethicone copolyol in a personal cleansing composition deems obvious. Applicants admit in the specification that the dimethicone copolyol herein employed is known in the art see page 17, herein. Fowler et al. also disclosed that examples using propylene glycol and dimethicone copolyol in personal cleansing composition. See. Particularly examples 2 and 8. As to the limitation “non-spherical” it is noted that Schulz Jr. et al. do not particularly require the powder to be spherical. The use of non-spherical would be within the purview of a skilled artisan possessing Schulz’s teaching.

(10) Response to Argument

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, In this case, the teaching, suggestion and motivation are found in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Schulz et al. teach the silicon elastomer gel herein and its usefulness as cosmetic cleansing agent, particularly for removing color cosmetics. Drechsler et al. teach transfer resistant cosmetic compositions may be removed by applying a dimethicone-based cosmetic remover to the skin or lips and rubbing the area gently with a tissue. Therefore, it would have

been obvious to one of ordinary skill in the art to employ the elastomer disclosed by Schulz for removing transition resistant cosmetics.

4. Appellants contend that “Schulz reference is primary directed to deodorant compositions” and “Schulz reference only mentions the use of its silicone elastomer as a color cosmetic remover in *a laundry list* of potential uses. Most of the specification and the examples are directed to antiperspirant and deodorant compositions. One skilled in the art would not look to Schulz’s teachings of solid antiperspirant and deodorant compositions to create a transfer resistant make-up removing composition” (emphases added). The arguments are untenable. It is well settled that Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Further, the so-called “laundry list” does not contain many items, and all the items in the list are closely related to cosmetics. See, col. 7, lines 53-60.

5. Appellants further contend that the cited references do not teach each and every limitation recited in the claims. The examiner disagrees.

As to the particular solvent, it is noted the preferred solvent herein is cyclodimethicone (D4 or D5) (see page 10, lines 3-4 in the specification). Schulz particularly preferred D4 cyclodimethicone as the swollen agent. See, particularly, example I in column 6, wherein the elastomer was prepared with octamethylcyclotetrasilicone (cyclodimethicone D4) as solvent, with a ratio of elastomer to solvent 1:6. The obtained solid gel was further swollen with cyclodimethicone. Drechsler et al. particularly teach that dimethicone based remover would be useful for removing transfer resistant cosmetics. Therefore, one of ordinary skill in the art would have been motivated to either use the silicone elastomer gel disclosed by Schulz et al., which

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contains substantial amount of cyclodimethicone, or if necessary, incorporate further amount of cyclodimethicone with the elastomer solid for the removal of transfer resistant cosmetics.

Regarding the limitation “non-spherical” it is noted that appellants did not dispute that the elastomer particles disclosed by Schulz may be actually non-spherical. Applicants merely argue that Schulz do not particularly require the elastomer particle be non-spherical. The examiner contends since Schulz’s elastomer is disclosed by the application as useful in the claimed invention, it would have reasonably assumed that the elastomer possesses the properties claimed herein. Note any properties exhibited by a composition are inseparable from the composition and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical composition, the properties, such as the physical shape, applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990. See MPEP 2112.01.

Alternatively, the use of non-spherical particles would have been an obvious option since Schulz et al do not have particularly requirement for the shape of the particles, and the particles can only be either spherical or non-spherical.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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For the above reasons, it is believed that the rejections should be sustained.

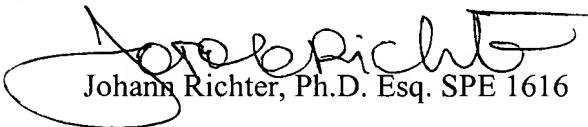
Respectfully submitted,

Shengjun Wang


SHENGJUN WANG
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